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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,963	06/20/2003	Robert Przekwas	10739.14.187	6622

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EXAMINER

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ART UNIT	PAPER NUMBER
3618	

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/600,963	PRZEKwas ET AL. <i>ST</i>	
	Examiner	Art Unit	
	Bryan Fischmann	3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 June 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 June 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09-22-2003</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

Specification

1. The specification is objected to due to the following:

A) It is unclear what structure is being referred to by recitation of "The coupling" in line 20 of page 6.

See also line 11 of page 8.

B) It is believed that the recitation of "a aperture" on line 8 of page 7 is grammatically incorrect.

C) Lines 9-11 of page 8 recites "The spindle 56 is secured to the bridge 44 by inserting the bushing 66 through the aperture 64 of the mounting collar 62 and positioning the mounting collar 62, with the bushing 66 inserted thorough the aperture 64, between the side portions 46".

It is considered unclear from this recitation how the bushing is inserted into the aperture of the mounting collar and also between the side portions 46 of the bridge 44.

See the 112 1st portion of this Office Action for further discussion.

Drawings

2. Figure 2 is objected to, as there appear to be several small reference numbers, such as 2, 3 and 7, in the vicinity of the ski, that do not appear associated with the Instant Invention and are not identified in the disclosure. Also, the far left portion of Figure 2 appears to show a short lead line pointing toward a "rectangular-shaped object that is not associated with a reference number".

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the below must be shown or the features canceled from the claims. No new matter should be entered.

Claim 1 recites "a bushing for coupling the ski to the spindle, the bushing having a flange for offsetting the spindle to an edge of the ski".

Independent claims 6, 11 and 14 contain a similar recitation in varying detail.

It is not believed that Applicant has illustrated the necessary details as to how the bushing is inserted into the aperture of the mounting collar and also between the side portions 46 of the bridge 44 to enable the offsetting of an edge of a ski to the spindle. See the 112 1st paragraph rejection below for additional details.

4. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

The drawings are considered informal, as the reference numbers and associated lead lines are not uniform and well defined.

Claim Objections

5. Claims 14-19 are objected to because of the following:
- A) It would seem that wording would be improved if the word "the" appeared before the word "snowmobile" in line 2 of claim 14.
 - B) There is a space missing between the word "about" and the number "2.0" in the first line of claim 15.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claim 1 recites "a bushing for coupling the ski to the spindle, the bushing having a flange for offsetting the spindle to an edge of the ski".

Independent claims 6, 11 and 14 contain a similar recitation in varying detail.

Adequate written description is believed lacking for this recitation due to the following:

1) Support for this claim 1 recitation is believed to be found in lines 9-11 of page 8 of the specification which recites "The spindle 56 is secured to the bridge 44 by inserting the bushing 66 through the aperture 64 of the mounting collar 62 and positioning the mounting collar 62, with the bushing 66 inserted thorough the aperture 64, between the side portions 46".

2) It is considered unclear from this recitation how the bushing is inserted into the aperture of the mounting collar and also between the side portions 46 of the bridge 44 to enable the offsetting of an edge of a ski to the spindle.

3) Note that the bushing length from Figure 4 is the length of the first section 74, plus the length of the second section 76, plus the offset flange (48) thickness. It is best understood that the bushing length must be greater than the distance between the "inside faces" of the side portions 46 of the bridge 44, in order for the bushing to retain the spindle to the side bracket.

4) If the bushing is inserted into the aperture 44 of the mounting collar 62 before the mounting collar is located between the side portions 46 of the bridge 44, note that the bushing length mentioned in the previous paragraph would then prevent the mounting collar from being located between the side portions of the bridge, as it has already been determined above that the bushing length must be greater than the distance between the inside faces of the side portions of the bridge.

5) If the bushing is inserted into the aperture 44 of the mounting collar 62 after the mounting collar is located between the side portions 46 of the bridge 44, note that the bushing would then have to be inserted through aperture 48. While this would be possible with a "large enough" aperture, note that providing such a large aperture would then allow the bridge 44 and ski 18 to apparently experience unwanted "sideways movement" in at least one sideways direction, as the bolt head of bolt 86 would then not be retained by the bridge, as it would be free to pass through aperture 48. Note also that Applicant has illustrated on Figure 5 offset flange 48 as being a larger outer diameter than the outer dimension of the "bolt head" of bolt 86.

While Applicant may contend that the bolt head of bolt 86 and nut 88 were intended to be larger than the flange 48, that such a "standard bolt and nut", if available,

would likely have to carry very large shear stresses across only a small portion of the outer dimensions of the bolt head of the bolt and nut and a corresponding small portion of the side portions. While such a contention would likely not be rejectable under 112¹ paragraph, the Examiner notes that it raises questions of whether the bolt head and nut would be prone to failure. Note also that such a contention would raise questions of new matter.

Additionally note that the outer diameter of the bushing, into which the bolt is inserted, is larger than the outer diameter of the bolt, making it unlikely that the bushing offset flange outer diameter, which is larger than the outer diameter of the bushing, would then be less than the outer dimension of a bolt head of any standard bolt.

6) Due to this, unless the Examiner has misunderstood some aspect of the design, it would appear that additional undisclosed features, such as a "specially made bolt and nut assembly", with a "stepped extra wide bolt head" and "stepped extra wide nut", or the use of a collar between the bolt head and side portion and nut and side portion would be required.

7) Accordingly, it is not believed that Applicant was in possession of the necessary details to reduce to practice the Instant Invention at the time the invention was made.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Piedboeuf, US Patent 3,693,992.

Piedboeuf teaches a snowmobile having an adjustable width ski stance comprising:

a ski (14) having an inside edge and an outside edge;
a spindle (18) extending generally upward from the ski; and
a bushing (52 and 52') for coupling the ski to the spindle, the bushing having a flange (56, 56') for offsetting the spindle relative to an edge of the ski (see comments below).

Regarding the claim 1 limitation "for offsetting the spindle relative to an edge of the ski", and similar limitations in other claims, it is noted this limitation is functional language. The functional recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the function or intended use, then it meets the claim. *In re Casey*, 370 F.2d 576, 152 USPQ 235, 238 (CCPA 1967). It is the Examiner's position that the

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prior art is capable of performing the recited functions, as if one of the bushings, 52, 52', or both were not present, the position of the spindle relative to a side, or bottom edge of the ski would change. Therefore, the bushing "offsets" the spindle to an edge of the ski.

Once this *prima facie* case has been established, the burden shifts to the applicant to show that the prior art structure does not possess the functionally defined limitations of his claimed apparatus. *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

Regarding claim 3, see reference numbers 22, 24 and 26.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-4, 6-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Metheny, US Patent 5,145,201, in view of Chaumont, US Patent 3,613,809.

Metheny teaches a snowmobile having an adjustable width ski stance comprising:

a ski (Figures 1 and 2) having an inside edge and an outside edge; and

a bushing (117 and 118) for coupling the ski to a snowmobile, the bushing having a flange (Figure 3) for offsetting the spindle relative to an edge of the ski (see comments below).

Metheny fails to explicitly teach a spindle extending generally upward from the ski, or otherwise illustrate how the ski is attached to the snowmobile, other than lines 31 and 32 of column 4 which recite "...a connector bolt 119 therein for connecting the ski to the suspension of a snowmobile".

However, Chaumont teaches a spindle (40) extending generally upward from the ski. A spindle facilitates coupling a snowmobile to a ski.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a spindle to couple a snowmobile to the ski of Metheny, as taught by Chaumont.

Regarding the claim 1 functional limitation "for offsetting the spindle relative to an edge of the ski", and similar limitations in other claims, the comments regarding functional language in the 102 portion of this Office Action generally apply. Also note that if the flange portions of the bushings of Metheny were not present that the ski of Metheny would be able to move relative to the spindle of Chaumont, thus affecting the "offset" of the spindle relative to the edge of the ski.

Regarding claims 3 and 7, see reference number 42 of Chaumont.

Regarding claims 4 and 7, see reference number 44 of Chaumont.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hoffman, Yasui, et al, Marier and Cormican – teach snowmobile skis

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis, can be reached on (703) 308-2560. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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PRIMARY EXAMINER
11-19-4